

REMARKS

This is a full and timely response to the non-final Official Action mailed September 16, 2009 (the “Office Action” or “Action”). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

By the preceding amendment, claims 1, 12, 24, and 52 have been amended. Additionally, new claims 75 and 76 have been added and original claim 23 has been cancelled. Thus, claims 1-9, 12-16, 19, 21, 24, 52, and 72-76 are currently pending for further action.

Prior Art:

Rejections under 35 U.S.C. §103(a):

1). In the recent Office Action, claims 1, 3-5, 12, 13, 15, 18, 19, 21 and 52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0122746 to Rignell (“Rignell”) in view of U.S. Patent Application Publication No. 2003/0001020 to Kardach (“Kardach”). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 1

Claim 1 recites:

A method of associating in computer memory (i) a digital electronic version of printed human-discernible content of a printed document comprising a sheet having a machine-readable pattern adapted to enable the position of a digital pattern reading device to be determined and said human-discernible content with (ii) the identity of a sheet upon which the content is printed, the method comprising:

printing the content onto a sheet using a second printer, said sheet comprising a pre-patterned sheet that has been pre-printed by a first printer with said pattern;

in which said first printer has a higher print resolution than the second printer;

transferring a machine-readable identity code between said second printer and said sheet at around the time of printing said content; and storing a correlation between said identity code and said digital electronic version in computer memory.

(Emphasis added)

Support for the amendment to claim 1 can be found in Applicant's originally filed specification at, for example, page 11, lines 34-36 – page 12, lines 1-7; page 37, lines 29-32; and originally filed claim 23.

In contrast neither Rignell nor Kardach teach or suggest a method comprising printing the content onto a sheet using a second printer, said sheet comprising a pre-patterned sheet that has been pre-printed by a first printer with said pattern; in which said first printer has a higher print resolution than the second printer.

The Office Action asserts that Rignell teaches “printing the content onto a sheet using a second printer, said sheet comprising a pre-patterned sheet that has been pre-printed by a first printer with said pattern.” (Action, page 3). In support of this, the Office Action cites to Rignell at page 2, paragraph 22, which, does not mention or specify any differences between any printers used to add content to a document. Specifically, the citation provided only

discusses using a “conventional printer,” but fails to define what a conventional printer is or how it may compare to any other printers if used in conjunction with another printer.

The Office Action takes official notice that “if the printed pattern can be printed by another printer, or pre-printed, then the printer that is doing the printing of the pattern would have better resolution than the second printer.” (Action, p. 17). The Applicant respectfully disagrees that the printer doing the printing of the pattern must necessarily be of a higher print resolution than the second printer. There is no suggestion from the prior art to assert that this is necessarily so. “The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being “well-known” in the art. In *re Ahlert*, 424 F. 2d 1088, 165 USPQ 418, 420 (CCPA 1970). However, the fact that one printer is of higher print resolution than another is not a fact outside of the record which is capable of instant and unquestionable demonstration. It simply does not follow that the use of one printer of a certain print quality necessarily requires the use of a second printer with lower (or higher for that matter) quality.

The Supreme Court recently addressed the issue of obviousness in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007). The Court stated that the *Graham v. John Deere Co. of Kansas City*, 383, U.S. 1 (1966), factors still control an obviousness inquiry. Under the analysis required by *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Rignell and Kardach, did not include the claimed subject matter, particularly as the prior art does not teach or suggest a method comprising printing the content onto a sheet using a second printer, said sheet comprising a pre-patterned sheet that has been pre-printed

by a first printer with said pattern; in which said first printer has a higher print resolution than the second printer.

The differences between the cited prior art and the indicated claims are significant because recitation of claim 1 provides the use of a second low resolution printer in place of a more expensive high resolution printer when adding content to a document comprising a machine-readable pattern. Thus, the claimed subject matter provides features and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 1 under 35 U.S.C. § 103 and Graham.

Therefore, for at least the reasons explained here, the rejection based on Rignell and Kardach of claim 1 and its dependent claims should be reconsidered and withdrawn.

Claim 12

Claim 12 recites:

A method of associating in computer memory a digital electronic version of printed human discernible content of a printed document with an identity code adapted to identify said document, the method comprising:

using a plurality of pages of pre-patterned digital paper that have been pre-printed by a first printer with a position-determining pattern, said pattern being adapted to enable a digital pen to acquire information from said pattern to enable the position of said pen on said pattern to be determined;

printing said content on said digital paper using a second printer;

using said second printer to convey an identity code to or from the paper; and

in which said identity code is a user-specific identity code and in which, upon recognition of said user-specific identity code, said second printer is caused to print user-specific content along with said human discernible content onto said pre-printed digital paper;

associating in computer memory, using said code transferred, at the time of printing said content onto said pre-patterned paper, a digital electronic version of said content with the identity code for the particular sheet of digital paper upon which said content is printed.

(Emphasis added)

Support for the amendment to claim 12 can be found in Applicant's originally filed specification at, for example, page 55, lines 9-36 – page 56, lines 1-4, and originally filed claim 17.

In contrast neither Rignell nor Kardach teach or suggest a method comprising using said second printer to convey an identity code to or from the paper; and in which said identity code is a user-specific identity code and in which, upon recognition of said user-specific identity code, said second printer is caused to print user-specific content along with said human discernible content onto said pre-printed digital paper.

First, it should be noted that the Office Action concedes that “Rignell in view of Kardach does not teach wherein different users have different identity codes associated with them and wherein upon recognition of their identity code from data from said second printer's identity code reading device said second printer is caused to print user-specific content onto said sheet.” (Action, p. 16) The Office Action, specifically in connection with claim 17, continues on by stating that Euchner does teach this. (*Id.*). In support of this assertion the Office Action cites to Euchner at column 5, lines 46-55 which read in pertinent that “separate uniquely identifiable pens are used to identify a particular user as the source of certain annotations” or alternatively that “each copy of the document is printed using different unique patterns and generic digital pens are used.” (*Id.*) The Applicant respectfully disagrees that Euchner anticipates claim 12.

There is no place in Euchner, and specifically in this section of Euchner, which teaches or suggests that a user-specific code is used to print both user-specific content as well as and along with said human discernible content onto said pre-printed digital paper. In fact, Euchner specifically teaches that the unique codes are tied to or correspond to a specific pen or document. (Euchner, Col. 5, ln. 45-50). Nowhere does it teach that the unique ID is tied to

a specific user. Even if it may be interpreted that the unique ID is tied to any one specific user, Euchner still fails to teach that **information about the user** is added to the human-discernable content being printed on the pre-patterned paper.

Again, the Court stated that the *Graham v. John Deere Co. of Kansas City*, 383, U.S. 1 (1966), factors still control an obviousness inquiry. Under the analysis required by *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Rignell and Kardach, did not include the claimed subject matter, particularly a method comprising using said second printer to convey an identity code to or from the paper; and in which said identity code is a user-specific identity code and in which, upon recognition of said user-specific identity code, said second printer is caused to print user-specific content along with said human discernible content onto said pre-printed digital paper.

The differences between the cited prior art and the indicated claims are significant because recitation of claim 12 provides for a method of providing to the user with a document on pre-printed digital paper containing both user-specific content and human discernible content. Thus, the claimed subject matter provides features and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 12 under 35 U.S.C. § 103 and *Graham*.

Therefore, for at least the reasons explained here, the rejection based on Rignell and Kardach of claim 12 and its dependent claims should be reconsidered and withdrawn.

Claim 52

Claim 52 recites:

A method of combining pen strokes made with a digital pen upon a digital sheet having pen position-determining pattern printed upon it and human-discernible content printed upon it comprising:

- printing said sheet with said pattern in a pre-patterning operation with a first printer to create a pre-patterned sheet;
- subsequently printing said content onto said pre-patterned sheet using a second printer to create a content-printed digital sheet;
- transferring an identity code between said second printer and said sheet to enable the identity of said sheet to be established in a subsequent pen-on-sheet writing operation, the transfer of said identity code occurring in the same time frame as printing said content onto said sheet;
- in which said identity code corresponds to a predetermined set of human-discernible content and in which, upon recognition of said identity code, said second printer is caused to print user-specific content along with said predetermined set of human-discernible content onto said pre-printed digital paper;**
- associating in computer memory a link between said identity code and an electronic version of said content that was printed on said sheet;
- using a digital pen to make pen strokes on said content-printed sheet;
- conveying pen-acquired pen-position data, relating to the position of said pen in said pattern to a processor;
- using the digital pen to acquire said identity code from said content-printed sheet;
- the processor using the pen-acquired identity code, the pen acquired pen-position data, and the link between said identity code and said electronic version of said content to combine said pen strokes with said content.

(Emphasis added)

Support for the amendment to claim 52 can be found in Applicant's originally filed specification at, for example, page 56, lines 6-36 – page 57, lines 1-13, and originally filed claim 17.

In contrast neither Rignell nor Kardach teach or suggest a method comprising transferring an identity code between said second printer and said sheet to enable the identity of said sheet to be established in a subsequent pen-on-sheet writing operation, the transfer of said identity code occurring in the same time frame as printing said content onto said sheet in which said identity code corresponds to a predetermined set of human-discernible content and

in which, upon recognition of said identity code, said second printer is caused to print user-specific content along with said predetermined set of human-discernible content onto said pre-printed digital paper.

Similar to the arguments above in support of claim 12, the prior art specifically fails to teach an identity code which corresponds to a predetermined set of human-discernible content and in which, upon recognition of said identity code, said second printer is caused to print user-specific content along with said predetermined set of human-discernible content onto said pre-printed digital paper. Again, the closest the Office Action comes to asserting that the prior art teaches this is in the analysis in connection with claim 17 as recited above. (Action, p. 16). Specifically, neither Rignell, Kardach, nor Euchner teach that a identity code is associated with a predetermined set of human-discernible content such that upon recognition of the identity code placed on the sheet, the second printer prints off user-specific content as well as and along with a predetermined set of human-discernible content.

The Court stated that the *Graham v. John Deere Co. of Kansas City*, 383, U.S. 1 (1966), factors still control an obviousness inquiry. Under the analysis required by *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Rignell and Kardach, did not include the claimed subject matter, particularly a method comprising transferring an identity code between said second printer and said sheet to enable the identity of said sheet to be established in a subsequent pen-on-sheet writing operation, the transfer of said identity code occurring in the same time frame as printing said content onto said sheet in which said identity code corresponds to a predetermined set of human-discernible content and

in which, upon recognition of said identity code, said second printer is caused to print user-specific content along with said predetermined set of human-discernible content onto said pre-printed digital paper.

The differences between the cited prior art and the indicated claims are significant because recitation of claim 52 provides for a printed document on pre-printed patterned paper containing both user-specific content as well as a predetermined set of human-discernable content. Additionally the recitation of claim 52 further provides a method of printing a document without the use of a computer. Thus, the claimed subject matter provides features and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 52 under 35 U.S.C. § 103 and Graham.

Therefore, for at least the reasons explained here, the rejection based on Rignell and Kardach of claim 52 and its dependent claims should be reconsidered and withdrawn.

2). In the recent Office Action, claims 2, 6-9, 14, 16, and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0122746 to Rignell (“Rignell”) in view of U.S. Patent Application Publication No. 2003/0001020 to Kardach (“Kardach”) in further view of U.S. Patent No. 7,111,230 to Euchner et al. (“Euchner”). The rejection of claims 2, 6-9, 14, 16, and 17 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claims 1 and 12.

Additionally, various dependent claims of the application recite subject matter that is further patentable over the cited prior art. Specific, non-exclusive examples follow.

Claim 2

Claim 2 recites “A method according to claim 1 wherein said identity code is read from said sheet **by said second printer.**” (Emphasis added) In contrast, neither Rignell, Kardach, nor Euchner teach or suggest the method of claim 2, wherein said identity code is read from said sheet by said second printer.

The Office Action concedes that “Rignell in view of Kardach does not teach wherein said identity code is read from said sheet by said second printer.” (Action, page 11). However, the Office Action asserts that “Euchner further teaches wherein said identity code is read from said sheet by said second printer.” (*Id.*) In support of this assertion, the Office Action cites to Column 9, lines 19-25 which says in pertinent part “a **digital paper scanner is used** when printing the hardcopies in order to associate a particular digital paper identifier with the electronic master document.” However, Euchner fails to teach that the second printer reads the identity code found on the sheet. Although Euchner later teaches that “each page of the digital paper may use a different pattern space and may be scanned as printed.” (Euchner, col. 9, lines 24-26). This, however, does not add any further weight to the assertion by the Office Action that Euchner teaches that a second printer in fact reads the identity code.

Again, the Court stated that the *Graham v. John Deere Co. of Kansas City*, 383, U.S. 1 (1966), factors still control an obviousness inquiry. Under the analysis required by *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Rignell, Kardach, and Euchner did not include the claimed subject matter, particularly the prior art does not

teach or suggest the method of claim 1, wherein said identity code is read from said sheet by said second printer.

The differences between the cited prior art and the indicated claims are significant because recitation of claim 2 provides for a printer that simultaneously reads the unique identification code and prints to the document thereby associating the unique code with the electronic copy of the document stored on the personal computer. Thus, the claimed subject matter provides features and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 1 under 35 U.S.C. § 103 and Graham.

Therefore, for at least the reasons explained here, the rejection based on Rignell, Kardach, and Euchner of claim 2 and its dependent claims should be reconsidered and withdrawn.

3). In the recent Office Action, claims 23 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0122746 to Rignell (“Rignell”) in view of U.S. Patent Application Publication No. 2003/0001020 to Kardach (“Kardach”). The rejection of claims 23 and 24 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 1.

4). In the recent Office Action, claims 72-74 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0122746 to Rignell (“Rignell”) in view of U.S. Patent Application Publication No. 2003/0001020 to Kardach (“Kardach”) in further view of U.S. Patent No. 7,050,181 to Korst et al. (“Korst”). The

rejection of claims 72-74 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claims 1, 12 and 52.

Conclusion:

In view of the preceding arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

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